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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,375	02/29/2004	Mary K. Boncutter	52052/MEG/R541	9358
23363	7590	07/20/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			KAVANAUGH, JOHN T	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	

3728

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/790,375

Applicant(s)

BONCUTTER ET AL.

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-33 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 14-33 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10,11,18-27,29-31 are rejected under 35 U.S.C. 102(a & e) as being anticipated by US 6021585 (Cole).

Cole teaches a method of producing a footwear substantially as claimed including providing an outsole (14), an insole (12) having an inner structure of thermoplastic resin (see col. 4, lines 30-33; EVA is a thermoplastic resin), immersing the inner structure in vinyl polymer to form an outer coating that is a water barrier (see col. 5, lines 4-12 and col. 4 lines 11-29; polyvinyl chloride is a vinyl polymer and is inherently a water barrier). Regarding claim 23, the density of the EVA insole is a low density; see col. 4, lines 30-32. Regarding claim 32, inasmuch as the structure and the material is the same as applicants the footwear is naturally buoyant. Regarding claim 26, it is well known in the art that outsoles are wear resistant especially relative to the insole to prolong the life of the sole. Regarding claims 11, 30 and 31, see figure 3, which shows the indentations formed in the insole and therefore there is apertures provided in the

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inner structure. Regarding the apertures formed "before immersing the inner structure", Cole teaches the insole can be completely covered (see col. 5, line 8) and therefore the dipping process (immersing) would be performed after the apertures are formed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16, 28, 32 and 33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cole '585.

Cole teaches the method of producing footwear (see the rejection above) except for the thermoplastic resin contains plasticizer (claim 28) and rubber and PVC (claims 32-33). Regarding claim 16, Cole lacks the thermoplastic resin composition comprising NBR, polyvinyl chloride past resin, filler talc, foaming agent, plasticizer and process oil. Thermoplastic resin compositions typically contain various combinations of rubber, PVC, plasticizer and the other elements listed in claim 16 and therefore these features are taught. To the extent that they are not, it would have been obvious to construct the inner structure of the insole of Cole with the thermoplastic resin comprising rubber, PVC and plasticizer, etc., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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5. Claim 14,15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole '585 in view of Official Notice.

Cole teaches a method as claimed except is silent with regard to if a color pigment was added to the composition forming the outer coating (i.e. the vinyl polymer coating). The examiner takes official notice that is it old and conventional in the art to add a color pigment to a composition to provide an attractive and aesthetic appearance. Therefore, it would have been obvious to provide the method of Cole with the step of adding a color pigment in forming the outer coating of the insole, to provide an attractive and aesthetic appearance. Regarding the selection of the color pigment in accordance with a color of the upper members, it would have been obvious to construct outer coating of the insole and the upper members as taught above with any appropriate change in appearance such as a designated color inasmuch as there is no functional relationship of the color of the footwear and the structure of the footwear. It would be an obvious design choice to construct the footwear with any desired color to provide a pleasing appearance to the wearer.

***Allowable Subject Matter***

6. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments filed June 23, 2005 have been fully considered but they are not persuasive.

Applicant argues that Cole does not teach "immersing the inner structure in vinyl polymer to form an outer coating that is a water barrier" since this step is actually an additional step applied to leather or non-leather step. Applicant argues that the "finish" is a continuous layer with is not a substitute for the leather or non-leather covering but an additional, optional step that is applied after the leather or non-leather layer covering is applied to form the component. Applicant points out that this argument was presented in the related application 90/007172 and it was believed that the rejection was overcome in the interview with Examiner Stashick on Feb. 9, 2005.

In review of the related application, it would appear the Examiner did not withdraw this rejection; see the top of page 5 of the office action mailed July 5, 2005. Partially or completely covering the exposed surfaces of a formed component with non-leather such as the material described for the upper components or optionally utilizing finishes, made of the same material as the upper, can be applied to the EVA with the finish being sprayed, dipped or hand-panted. Therefore, the spraying, dipping or hand-painting of the finish to completely cover the EVA meets the continuous layer portion of the claim. Moreover, see col. 5, lines 5-6 of Cole, wherein it states "EVA, covered with leather, **or** optionally any of the following methods".

Applicant argues the structure of Cole is not formed by immersing.

To the contrary, see col. 5, lines 4-12; particularly line 12, wherein it states, "dipping". The definition of "dipping" is "to put into or under a liquid.... **immerse**", according to Webster's New World Dictionary, Third College Edition.

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Applicant argues "Cole does not discuss the use of sandals in or near water or of the desirability of a water barrier".

In response, the claims don't call for a sandal and therefore this argument is moot. Moreover, Cole does teach the present invention can be used with rafting shoes; see col. 6, lines 18-20. Rafting shoes are used in or near water.

### ***Conclusion***

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Conclusion***

**9. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

**--"The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references."**

**--"A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."**


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**-Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
July 19, 2005